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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,737	05/10/2006	Jceng-Bong Yoon	1455-061439	5018
28289 7590 06/03/2010 THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219				
EXAMINER				
KESSLER, CHRISTOPHER S				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
06/03/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/578,737	Applicant(s) YOON ET AL.
Examiner CHRISTOPHER KESSLER	Art Unit 1793

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 May 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 83,85,87-122 and 163-165.
Claim(s) withdrawn from consideration: 123-162 and 166-168.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/ Roy King/
Supervisory Patent Examiner, Art Unit 1793

Continuation of 3. NOTE: the amendments to claims 99 and 114 raise new issues for consideration that were not presented in the prior claims..

Continuation of 11. does NOT place the application in condition for allowance because: The amendment raises new issues for consideration in the claims.

Applicant argues that the finality of the Office action is premature, because the claims could have been rejected under Kodama previously. The examiner disagrees for two reasons. Firstly, the scope of independent claims 83, 85, 95 and 108 were all changed via amendment. The examiner could not have foreseen the amendment by applicant to delete various portions of the claims. Applicant could just as easily have added portions to the claim in order to overcome the rejection under section 112. The amendments to the claims change the scope of the claims. Secondly, even if the rejection over Kodama is premature to be made final, applicant has still not overcome the rejection over Murakami.

Applicant argues that the invention differs from that of Murakami. Applicant argues that the invention relates to sheet used for automobiles, electronic appliances and the like, while Murakami is directed to manufacturing of a can. However, the intended use of the steel sheet as claimed is not sufficient to overcome the prior art rejections. Firstly, applicant is arguing features which are not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, the technical field of the invention is not relevant to the rejection of the claims, but rather to the disclosure in general. Secondly, all of the limitations of the claim would have been obvious to one of ordinary skill in the art, for the reasons stated in the rejection. Even if the intended use of the steel were claimed, this would not be sufficient to rebut the prima facie case of obviousness. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation").

Applicant argues that Murakami does not teach or suggest the claim limitation regarding the composition range of Mn/S, Cu/S, Mn+Cu and (Mn+Cu)/S. The examiner agrees that Murakami does not teach the limitations as claimed. However, said limitations would have been obvious to one of ordinary skill in the art at time of invention, for the reasons stated in the rejection and in section 9 of the prior Office action.

Applicant further argues that Murakami does not teach the limitations of the size of the precipitates in the steel. The examiner agrees with this statement, however, the claimed steel would have been obvious to one of ordinary skill in the art. Murakami teaches that the composition of the steel, especially of Mn, Cu and S, is carefully controlled in order to form precipitates that will enhance the mechanical properties of the steel (see pp. 17-8 as cited previously). As was stated previously, Murakami teaches that the ratios of the elements overlaps the claimed ratios. Thus, the steel with the claimed composition and structure would have been obvious to one of ordinary skill in the art due to the teachings of Murakami of the importance of control over the precipitates to make a steel having desirable mechanical properties.

Regarding the Applicant's parallel arguments for the Kodama reference, the examiner notes that the technical field is not claimed, and is also not sufficient to rebut the prima facie case of obviousness. Regarding the compositional limitations, the examiner agrees that Kodama does not teach the claimed ratios, however they would have been obvious to one of ordinary skill in the art for the reasons stated in the rejection. Regarding the size of the inclusions, applicant argues that precipitates in the claimed range are not apparent from Figure 1 of Kodama. However, Kodama as previously cited explicitly teaches that the range of precipitates is 0.05-2 microns (see [0008], [0011]-[0013] and claim 1; especially [0013]). Thus applicant has not rebutted the prima facie case of obviousness based on the overlapping range.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER KESSLER whose telephone number is (571)272-6510. The examiner can normally be reached on Mon-Fri, 9-5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.